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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,932	05/13/2005	Joseph Kaplo	TXT-001CP	3664
51414	7590	10/04/2007		
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			EXAMINER SELLS, JAMES D	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,932

Applicant(s)

KAPLO ET AL.

Examiner

James Sells

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-25-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6-7, 15-21 and 32-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Horton (US Patent 4,148,953).

Regarding claim 1, Horton discloses a method of making a pile weatherstripping. As shown in Figs. 1-2, this method involves wrapping membrane 16 around endless band 10; winding yarn or pile material 18 over membrane 16; attaching backing strip 22 to the pile material; and cutting the membrane 16 and pile 18 with slitter 32.

Regarding claims 2-3, stripper wires 12 space membrane 16 from endless band 10.

Regarding claims 6-7, stripper wires 12 space pile material 18 from endless band 10.

Regarding claim 15, ultrasonic heads 30 weld backing strips 22, membrane strip 16 and pile 18.

Regarding claim 16, Fig. 2 of Horton shows first and second backing strips.

Regarding claim 17, stripper wires 12 function as applicant's claimed stationary element.

Regarding claim 18, Fig. 3 of Horton shows the completed weatherstripping.

Regarding claim 19, Horton discloses an apparatus for making a pile weatherstripping. A shown in Figs. 1-2, this apparatus comprises forming head for wrapping membrane 16 around endless band 10; weaving head 20 for winding yarn or pile material 18 over membrane 16; an attaching station including ultrasonic heads 30 for attaching backing strip 22 to the pile material; and slitting station including slitter wheels 32 for cutting the membrane 16 and pile 18.

Regarding claims 20-21, stripper wires 12 space membrane 16 from endless band 10.

Regarding claim 32, ultrasonic heads 30 weld backing strips 22, membrane strip 16 and pile 18.

Regarding claim 33, Fig. 2 of Horton shows first and second backing strips.

Regarding claim 34, stripper wires 12 functions as applicant's claimed stationary element.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5, 8-14 and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton as described above in paragraph 2.

Regarding claims 4 and 22, it is the examiner's position that the specific location of the stripper wire or stationary element is within the purview of one having ordinary skill in the art and would have been obvious to employ in the method of Horton in order to achieve the predictable result of forming a weatherstripping with different pile lengths.

Regarding claims 5 and 23, it is the examiner's position that overlapping edges of the membrane or fin material is well known and conventional in the art and would have been obvious to employ in the method of Horton in order to provide the predictable result providing a stronger weatherstripping with more membrane material between the pile.

Regarding claims 8-14 and 24-31, it is the examiner's position that the two species of a stationary element and a traveling element are functionally equivalent alternate expedients in the art. In addition, the specific number, position and configuration of such elements claimed by the applicant appears to be in the realm of mechanical skill. Therefore it would have been obvious to one having ordinary skill in the art to substitute one for the other in order to achieve predictable results based on the physical requirements of the materials being manufactured.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,974,512.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of applicant's claims 1-34 are contained within or made obvious by claims 1-21 of U.S. Patent No. 6,974,512.

Telephone/Fax

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is 571-272-1237.

The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'J Sells', with a horizontal line drawn through the middle of the signature.

JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700